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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,182	12/21/2001	George C. Allen JR.	P21747	4402
7055	7590	09/07/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C.			HARPER, KEVIN C	
1950 ROLAND CLARKE PLACE			ART UNIT	
RESTON, VA 20191			PAPER NUMBER	
			2666	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/024,182

Applicant(s)

ALLEN ET AL.

Examiner

Kevin C. Harper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2, 4-6</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***Claim Objections***

1. Claim 7 is objected to because "A method" should be --An ATM based distributed virtual tandem switching method-- as recited in the claims dependent upon claim 7. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 and 19-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 14 and 21-25 of U.S. Patent No. 6,169,235. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-12 and 19-20 are a subset of claims 1, 14 and 21-25. In removing functional language, the scope of the claims is merely broadened by eliminating elements and their functions. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 365 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art).

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Therefore, it would have been obvious to one skilled in the art at the time the invention was made to not recite a CS-IWF providing information to a T-IWF in the '235 patent.

3. Claims 13-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 14 and 21-25 of U.S. Patent No. 6,169,735 in view of Goldman et al. (US 6,134,235). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 13-18 are a subset of claims 1, 14 and 21-25. In removing functional language, the scope of the claims is merely broadened by eliminating elements and their functions. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 365 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to not recite a CS-IWF providing information to a T-IWF in the '235 patent. Further, the '235 patent does not recite computer readable media for storing programs. Goldman discloses computer readable media for storing programs to implement a POTS/packet bridge (col. 8, lines 15-64). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite a computer readable media in the '235 patent in order to flexibly implement communications conversion by using a computer.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 7-8 and 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldman et al. (US 6,134,235).

4. Regarding claims 1, 7 and 13, Goldman discloses a distributed ATM network for transmitting voice (Figure 2A; abstract, lines 1-2) including a CS-IWF device (item 202; col. 9, lines 57-66 and col. 10, lines 5-25) and T-IWF devices (items 203; col. 10, lines 5-25 ; Figure 2B; col. 7, lines 10-13; col. 9, lines 4-7), where the T-IWF devices inherently receive the in-band signaling from the CS-IWF device (col. 13, lines 51-60). The CS-IWF device provides a single connection between the narrowband signaling network and the ATM network (Figure 2A, 202). Further regarding claim 13, the network includes an inherent computer readable medium storing a program for implementing the interworking functions, where the computer readable medium comprises code (col. 8, lines 15-64).

5. Regarding claim 2, 8 and 14, the narrowband signaling is SS7 (Figure 2A, item 112).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-6, 9-12 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al. (US 6,134,235) in view of Choudhury et al. (US 5,933,412).

6. Regarding claims 3-6, 9-12 and 15-18, Goldman discloses converting narrowband signaling to broadband signaling (Figure 2A) for an ATM network (col. 9, line 6; col. 7, line 10-13). However, Goldman does not disclose that the broadband signaling is PNNI, B-ISUP, or UNI, or that a switched virtual connection is dynamically setup. Choudhury discloses standardized broadband signaling for ATM that is PNNI, B-ISUP or UNI (col. 3, lines 54-55; col. 4, lines 53-54; col. 10, lines 13-15) used for setting up connections in an ATM network; abstract, lines 1-6). Therefore, it would have been obvious to use PNNI, B-ISUP or UNI broadband signaling and setup dynamic connections in the invention of Goldman in order to properly communicate setup signaling among various internal and border ATM nodes and to use network resources on an as-needed basis for conservation, respectively.

### ***Conclusion***

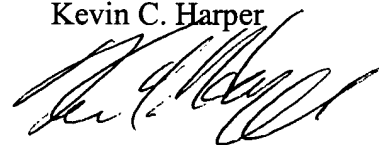
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 571-272-3166. The examiner can normally be reached weekdays from 11:30 AM to 8:00 PM ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 571-272-3174. The centralized fax number for the Patent Office is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only (applications must be associated with a customer number). For more information about the PAIR system, see [pair.uspto.gov](http://pair.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin C. Harper



September 6, 2004